

REMARKS

Favorable reconsideration is respectfully requested in light of the following comments. No amendments are presented herein, so full consideration of this After-Final Response is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 1-6, 8-9, 1-13, 16-17 and 19-22 under 35 U.S.C. §103(a) as unpatentable over McLeod et al., U.S. Patent No. 6,450,228, in view of Clar, U.S. Patent No. 4,525,237, or Oosterlinck, U.S. Patent No. 6,187,128. Applicant asserts that the *prima facie* obviousness rejection is flawed.

The Examiner relies upon either Clar or Oosterlinck to suggest elements missing from McLeod et al. In particular, the Examiner has stated (page 4 of the Action) that:

It would have been obvious to make the apparatus of McLeod et al. with the orientation of elements shown by either Clar or Oosterlinck because Clar and Oosterlinck each show that this orientation is a functionally equivalent alternate expedient to the orientation of the analogous elements in McLeod et al.

There are several errors in this assertion. First, the Examiner appears to be asserting, even if not using the exact words, that it is obvious to combine these references simply because they are combinable. However, case law has firmly established that “because two references can be combined” does not, by itself, properly establish motivation to combine the references. Please see, for example, M.P.E.P. §2143.01(III). Thus, as motivation to combine has not been properly established, the *prima facie* obviousness rejection is flawed and should be withdrawn.

Moreover, changing the orientation of elements within the device disclosed by McLeod et al., as suggested by the Examiner, is not believed to be “a functionally equivalent alternate expedient”. A careful review of the primary reference reveals that the direction in which the adhesive film is applied and the direction in which the release layer is collected, as seen for example in Figures 5 and 7 of McLeod et al., are integral to how McLeod et al.’s device functions. Simply rearranging items, as apparently suggested by the Examiner, would likely interfere with the intended function of the device described by McLeod et al.

Thus, not only are the arrangements disclosed by the secondary references not functionally equivalent, they would likely result in a material change in the function of the McLeod et al. device. As discussed in the M.P.E.P. (please see §2143.01(V and VI)), such a modification

cannot be considered to be obvious. Again, the *prima facie* obviousness rejection is flawed and should be withdrawn.

Moreover, there does not appear to be any reasonable motivation provided, either by the primary reference or either of the secondary references, to combine elements as suggested by the Examiner. The primary reference does not appear to espouse any difficulties resulting from the configuration shown by McLeod et al. The secondary references do not appear to espouse any advantages to how they direct the first and second film layers once separated. The only apparent motivation to combine these references as suggested appears to come from the present application. Reconstructive hindsight is improper. Once again, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 7 and 14 under 35 U.S.C. §103(a) as unpatentable over McLeod et al., U.S. Patent No. 6,450,228, in view of Clar, U.S. Patent No. 4,525,237, or Oosterlinck, U.S. Patent No. 6,187,128, and further in view of Januska, U.S. Patent No. 4,775,442. Claims 1 and 12, from which claims 7 and 14 depend, respectively, have been distinguished above as being patentable over McLeod et al., Clar and Oosterlinck. Thus, claims 7 and 14 are similarly patentable over these three references. As Januska is not believed to remedy the noted shortcomings of the other references, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

In view of the above, Applicants submits that pending claims are in condition for allowance. Reconsideration is respectfully requested and a Notice of Allowance is earnestly solicited. Please continue to transmit any subsequent Communications to:

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Respectfully submitted,

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